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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,300	07/24/2000	Paul L. Hickman	HSC1P002A	7235

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PERKINS COIE LLP
101 JEFFERSON DRIVE
MENLO PARK, CA 94025-1114

EXAMINER

STORK, KYLE R

ART UNIT	PAPER NUMBER
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2178

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/625,300	Applicant(s) HICKMAN ET AL.	
	Examiner Jonathan D. Schlaifer	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed on 11/8/2004.
2. None of the claims have been cancelled.
3. Claims 1-31 are pending in the case. Claims 1, 21, and 27 are independent claims.

Claims 1, 21, and 27 have been amended. Claim 31 is new.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 21-22 and 27-28 remain rejected under 35 U.S.C. 102(b) as being unpatentable over Brown (USPN 5,740,361—filing date 6/3/1996)**
5. **Regarding independent claim 21**, Brown discloses in col. 3, lines 59- 67 and col. 4, lines 1-8, prior to the following acts, storing data useful for populating an HTML based form; (such data would be inherent to a hypertext system, such as font data), providing said HTML based form to a client machine coupled to a TCP/IP network (a password check box is provided to the client); at least partially automatically filling-in said form with suitable data selected from said data useful for populating said HTML based form (the font information or other structural information would be required to fill in the form) based upon input from said client machine (the user keys in the form), verifying information on said form based upon stored heuristics (since it is a password, it must be

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checked against the password database) and submitting said form to a receiving agency over said network (the password must be checked over a network).

6. **Regarding dependent claim 22**, Brown discloses in col. 3, lines 62-63 that the user name is obtained at the same time as the password, constituting a method for electronically filing documents further comprising adding additional information to said form based upon input from said client machine prior to verifying said information.
7. **Regarding independent claim 27**, it is a computer readable medium with instructions for performing the method of claim 21, and may be rejected under similar rationale.
8. **Regarding independent claim 28**, it is a computer readable medium with instructions for performing the method of claim 22, and may be rejected under similar rationale.
9. **Claims 31 is rejected under 35 U.S.C. 102(b) as being unpatentable over Woodcock Washburn Kurtz Mackiewicz & Norris LLP (“Woodcock Washburn Pioneers Electronic Filing of Trademark Registrations; Local Firm First to File Electronically”, December 1,1997), hereinafter Woodcock.**
10. **Regarding independent claim 31**, Woodcock discloses an automated electronic filing system for use in electronic prosecution of trademark applications (TEAS is such as system) comprising: a web server coupled to a wide area network (TEAS comprises a website); a receiving agency server coupled to said wide area network, said receiving agency server associated with a governmental agency responsible for the administration of trademark registration (TEAS is coupled to the USPTO); and a client machine couple to said wide area network for communication with said web server, such that said web server serves as an interface to said receivig agency server (TEAS is web-based), said

client machine providing information to said web server forming at least a part of an electronic document related to prosecution of a trademark application or maintenance of a trademark registration (TEAS carries out trademark prosecuting, said electronic document to be filed with said receiving agency server by said web server (TEAS is designed to file applications), said electronic document filed for further processing by said governmental agency in accordance with preestablished rules (trademark applications are inherently processed according to office regulations)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-9 and 12-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen et al. (USPN 6,493,722 B1—filing date 4/13/1999), hereinafter Daleen further in view of Pearson (USPN 6,023,684—filing date 10/1/1997)**
12. **Regarding independent claim 1**, in col. 4, lines 7-8, Daleen states that people identify databases as electronic filing systems, and Daleen's invention encompasses a database (item 104 in Figure 1). Daleen's documents are filed for further processing by a receiving agency associated with said receiving agency server in accordance with a procedure for which said receiving agency is in some manner responsible (because there would be no point in storing the documents indefinitely if they were never used).

Daleen's invention also includes a receiving agency server coupled to a wide area network (the referring page web server, item 106 in Figure 1). Daleen also discloses client machines coupled to a wide area network that communicates to the receiving agency server (the PC clients, item 112 in Figure 1). Daleen fails to disclose a web server coupled to a wide area network that serves as an interface to said receiving agency server. However, in Figure 2, Pearson shows the use of intermediate servers because, as implied by Pearson's discussion of the setup of the servers in col. 1-21. Pearson's discussion and the Figure indicates that one may employ a path such as a path from the client (26 or 28) to the web server (50) to the application server (56). Such a setup allows control and filtering of data flow. It would have been obvious to one of ordinary skill in the art at the time of the invention to add Pearson's intermediate web server to Daleen's invention in order to allow control and filtering of data flow.

13. **Regarding dependent claim 2**, Pearson's Figure 2 shows that Web server 50 and Application server 56 (the receiving agency server) communicate directly with each other without going through wide area network.
14. **Regarding dependent claim 3**, Daleen, in Figure 1, shows how to combine multiple servers into one machine (the referring page web server, the billing system, and the database server) in order to integrate their functionality smoothly. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the web server and the receiving agency server on the same machine in order to integrate their functionality smoothly.

15. **Regarding dependent claim 4**, Dahleen, in Figure 1, shows the use of a third party web server (108) that is separated from the referring web page server (106). It would communicate over the wide area network in order to allow the two servers to share information. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the servers communicate over the wide area network in order to allow the two servers to share information.
16. **Regarding dependent claim 5**, Dahleen's network is the Internet, which is a TCP/IP protocol network.
17. **Regarding dependent claim 6**, Dahleen's network is the Internet.
18. **Regarding dependent claim 7**, Dahleen fails to disclose that said web server and said client machine communicate with each other over said wide area network. However, Pearson shows that the clients (26 and 28) communicate with the Web Server (50) through the Internet (34) in Figure 2 in order to transmit information to be processed. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the client communicate with the web server over the wide area network in order to transmit information to be processed.
19. **Regarding dependent claim 8**, Pearson's network is the Internet, which is a TCP/IP protocol network.
20. **Regarding dependent claim 9**, Pearson's network is the Internet.
21. **Regarding dependent claim 12**, Daleen's invention integrates a billing system, which constitutes an automated electronic filing system wherein said web server transacts a financial transaction with said receiving agency server on behalf of said client machine.

22. **Regarding dependent claim 13**, Daleen's invention provides a message to the user (item 508 in Figure 5A) which constitutes an automated electronic filing system wherein said web server automatically provides a portion of said electronic document in response to a selection originating from said client machine.
23. **Claims 10-11 and 18-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen further in view of Pearson, further in view of Blackwell, Jr., et al. (USPN 5,857,191—filing date 7/8/1996), hereinafter Blackwell, Jr.**
24. **Regarding dependent claim 10**, Daleen and Pearson fail to disclose a filing system wherein communications between said client machine and said web server are at least partially encrypted. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that encryption may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt communications between said client machine and said web server to provide added security.
25. **Regarding dependent claim 11**, Daleen and Pearson fail to disclose a filing system wherein communications between said client machine and said web server are subject to authentication. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that authentication may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to authenticate communications between said client machine and said web server to provide added security.

26. **Regarding dependent claim 18**, Daleen and Pearson fail to disclose a filing system wherein communications between said receiving agency server and said web server are at least partially encrypted. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that encryption may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt communications between said client machine and said web server to provide added security.
27. **Regarding dependent claim 19**, Daleen and Pearson fail to disclose a filing system wherein communications between said receiving agency server and said web server are subject to authentication. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that authentication may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to authenticate communications between said client machine and said web server to provide added security.
28. **Claims 14-15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen further in view of Pearson, further in view of Hartman, et al. (USPN 5,758,324—2/8/1996), hereinafter Hartman**
29. **Regarding dependent claim 14**, Daleen and Pearson fail to disclose an automated electronic filing system further comprising an applicant machine coupled to said wide area network. However, Hartman discloses the use of an applicant machine in item 134 of Figure 1 in order to carry out outside transactions with the server. Hartman does not disclose that the connection is via the wide area network, but since Daleen's and

Pearson's inventions are both connected via a wide area network, it would have been obvious to have the connection occur via the wide area network because this would have been a convenient connection means. It would have been obvious to one of ordinary skill in the art at the time of the invention to use an applicant machine coupled to said wide area network because it would allow outside transactions with the server and because it would have been a convenient connection means.

30. **Regarding dependent claim 15**, Daleen and Pearson and Hartman fail to disclose an automated electronic filing system wherein said applicant machine communicates with said web server over said wide area network. However, the applicant machine in the arrangement of claim 14 is connected to the overall system by the wide area network, and the wide area network is an obvious method for the communications link (item 28, Figure 1) of Hartman, in accordance with the routing communications system of Pearson, because it is a convenient and versatile communications method. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the wide area network to allow communications between the web server and the applicant machine because it is a convenient and versatile communications method.

31. **Claims 16-17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen further in view of Pearson, further in view of Hartman, further in view of Blackwell, Jr.**

32. **Regarding dependent claim 16**, Daleen and Pearson and Hartman fail to disclose a filing system wherein communications between said applicant machine and said web server are at least partially encrypted. However, in col. 1, lines 38-40, Blackwell, Jr.

discloses that encryption may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt communications between said client machine and said web server to provide added security.

33. **Regarding dependent claim 17**, Daleen and Pearson and Hartman fail to disclose a filing system wherein communications between said applicant machine and said web server are subject to authentication. However, in col. 1, lines 38-40, Blackwell, Jr. discloses that authentication may be added to HTTP (which would be the means of exchanging information over the Internet) to provide added security. It would have been obvious to one of ordinary skill in the art at the time of the invention to authenticate communications between said client machine and said web server to provide added security.
34. **Claim 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen further in view of Pearson further in view of Lee (USPN 5,347,477—filing date 3/2/1993)**
35. **Regarding dependent claim 20**, Daleen and Pearson fail to disclose an automated electronic filing system wherein said web server provides said client machine with a form that can be at least partially automatically filled-in in response to said selection. However, Lee in the Abstract discloses the use of a Form that can be filled in as an operational metaphor in order to facilitate user access to computer functions. It would

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have been obvious to one of ordinary skill in the art at the time of the invention to use a form with input capacity in order to facilitate user access to computer functions.

36. Claims 23 and 25 and 29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway (USPN 5,604,802—filing date 7/18/1994)

37. Regarding dependent claim 23, Brown fails to disclose a method further comprising obtaining an electron signature prior to submitting said form to said receiving agency. However, Holloway, in col. 5, lines 33-55 describes the use of an electronic signature in order to increase the security of transactions. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate electronic signatures into Brown in order to increase the security of the form transactions of the invention.

38. Regarding dependent claim 25, Brown fails to disclose a method wherein said electronic signature is obtained from said client machine. However, in Holloway's disclose about electronic signatures in col. 5, lines 33-55, the signature is resident on smart cards, which may readily be seen to be analogous to the client machine, in that they serve as a ready point at which data is input into a network. It would have been obvious to one of ordinary skill in the art at the time of the invention to obtain the electronic signature from said client machine, because they serve as a ready means of inputting data into the network.

39. Regarding independent claim 29, it is a computer readable medium with instructions for performing the method of claim 23, and may be rejected under similar rationale.

40. **Claims 24 and 30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway, further in view of Wiitala et al. (USPN 6,122,622—filing date 2/18/1998)**
41. **Regarding dependent claim 24**, Brown and Holloway fail to disclose a method further comprising paying a filing fee to said receiving agency in conjunction with the submission of said form to said agency. However, Wiitala discloses that a filing fee should be submitted in conjunction with a form in order to facilitate registration. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate fees and forms into Brown and Holloway's work in order to facilitate registration.
42. **Regarding independent claim 30**, it is a computer readable medium with instructions for performing the method of claim 24, and may be rejected under similar rationale.
43. **Claim 26 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, further in view of Holloway further in view of Hartman**
44. **Regarding dependent claim 26**, Brown and Holloway fail to disclose a method wherein said electron signature is obtained from an applicant machine coupled to said TCP/IP network. However, Hartman discloses the use of an applicant machine in item 134 of Figure 1 in order to carry out outside transactions with a server. Hartman does not specifically disclose that the applicant machine would be connected by the TCP/IP network, but since communication in the method occurs via the TCP/IP network, it would have been obvious to one of ordinary skill in the art at the time of the invention to use TCP/IP as the connection. It would have been obvious to one of ordinary skill in the art

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at the time of the invention to integrate Hartman's work into Brown and Holloway's work in order to carry out outside transactions with a server.

Response to Amendment

45. Applicant's arguments filed 11/8/2004 have been fully considered but they are not persuasive.
46. With respect to the arguments regarding claim 1 and Daleen, the Examiner notes that in general, Daleen's documents are filed for further processing by a receiving agency associated with said receiving agency server in accordance with a procedure for which said receiving agency is in some manner responsible (because there would be no point in storing the documents indefinitely if they were never used).
47. With respect to claims 21 and 27, the Examiner notes that as noted in the rejections, there would be infrastructural elements such as fonts that would be previous to the forms, and hence the attorney's traversal is invalid.
48. The rejection of claim 31 stands for the reason set forth in this Office Action.

Conclusion

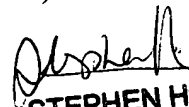
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Content-based Retrieval for Trademark Registration", National University of Singapore, Singapore, Singapore, November 3, 1996

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is (571) 272-4129. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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STEPHEN HONG
SUPERVISORY PATENT EXAMINER

JS